

The language added to Claim 15 that was cited by the Examiner (as well as in newly added claims 41-43) can be found in claims 1, 10, 11, and 14 as originally filed and as examined in the Office Action. As originally filed, claim 10 depended from claim 1 and recited “storing the position relevant Web content in a location bookmark area of the mobile terminal.” Claim 11 depended from claim 10 and recited “periodically updating the position relevant Web content.” Claim 14 depended from claim 11 and recited “automatically displaying the updated results in response to the relative position of the mobile terminal.”

Applicants submit that because a) claim 1 recites that “position relevant Web content” is stored “in a location bookmark area;” b) claim 11 recited “periodically updating the position relative Web content;” and c) claim 14 recited “displaying the updated results in response to the relative position of the mobile terminal,” that it was reasonable to assert that the amended language “periodically update the location bookmark in response to a relative position of the mobile terminal” has been considered by the Examiner and was subject to search and examination in the Office Action.

While Applicants regret the omission of claims 11 and 14 in support of the statements regarding claim 15, Applicants strongly disagree with the assertion made in the Official Communication that Applicants have engaged in conduct that is “against USPTO’s policies and hence would be notified to the highest level for appropriate action.” The Applicants have made every effort to ensure that the amendments encompass previously claimed subject matter as it being interpreted by the Examiner during prosecution. However, such amendments must also comply with the patent rules, such as in maintaining correct antecedent basis as required by 35 U.S.C § 112, second paragraph, which often necessitates altering the claim language somewhat.

In the Official Communication, the Examiner further requests that the Applicants show support for the amended language “store the location tagged Web content in a location bookmark area of the apparatus” as added by amendment to claim 21. Applicants note that originally filed claim 10 recited “storing the position relevant Web content in a location bookmark area of the mobile terminal.” Applicants do not dispute that the terms “location tagged Web content” and “position relevant Web content” are different in these claims, as are the terms “mobile terminal” and “apparatus.” However, as it relates to the present search and examination, Applicants can find no evidence that these different terms are being interpreted differently by the Examiner, and

therefore it is reasonable to assert that the amended language was subject to search and examination.

For example, on page 5, paragraph 8 of the Office Action, the Examiner rejects claim 1 as anticipated by Chasker, page 2. The Examiner has not highlighted any specific terms or excerpts from Chasker other than the page number to identify where the “position relevant Web content” is allegedly taught. On page 9, paragraph 28 of the Office Action, claim 21 is similarly rejected based solely on page 2 of Chasker, without citing any specific terms or excerpts to identify where the “location tagged Web content” is purportedly taught. This is also seen in the rejections of claims 1 and 21 in view of Barnes and Trossen, where page 2 of Barnes and page 3 of Trossen are cited as teaching the substance of both claim 1 and claim 21 (see Office Action at p 11, para. 34; p. 15, para. 54; p. 17, para. 60; and p. 21, para. 80).

Thus the Applicants have reasonably assumed that the Examiner is broadly interpreting the terms “position relevant Web content” and “location tagged Web content” to be equivalent in view of the cited art. As a result, the Applicants believe there is sufficient evidence of record for the Applicants to assert in good faith that the term “store the location tagged Web content in a location bookmark area of the apparatus” was subject to search and examination in the Office Action, based at least on the substance of the rejections of claims 1 and 21, and further based on the search and examination of claim 10, which recited “storing the position relevant Web content in a location bookmark area of the mobile terminal.”

Applicants further note that independent Claims 15 and 23 were rejected under 35 U.S.C. 102 based solely on page 2 of Chasker, page 2 of Barnes, and page 3 of Trossen, without the rejections highlighting any specifics regarding which particular teachings of the references apply to particular claim limitations. Therefore, while in the Official Communication the Examiner has not raised specific objections to these claims other than discussed above, Applicants believe that language added by way of amendment has been subject to search and examination based on the language of originally filed claim 1-14, and further in view of the broad interpretation of the claim language as evidenced by the substance of the rejections.

Finally, Applicants note for the record that the Applicants’ statement “that the Examiner’s next official communication can not be made final on the basis that Applicant’s amendments to the claims necessitated a new grounds of rejection requiring further consideration and/or a new

search” merely addresses a single issue related to the issuance of a final rejection (see MPEP § 707.07(a)). Such statements do not preclude the Examiner from respectfully disagreeing with the assertions of the Applicants, nor would it preclude the Examiner from issuing a final rejection for other reasons.

Accordingly, these assertions, which were made in good faith and with support in the record, can not reasonably be characterized as “intentional statements for unnecessarily avoiding final office actions ... contrary to the USPTO’s efforts for expediting the prosecution of the case” as was stated by the Examiner in the Official Communication. Applicants are merely requesting full consideration for intended scope of the amendments as provided for in MPEP § 707.07 [R-3]:

While the rules no longer give to an applicant the right to “amend as often as the examiner presents new references or reasons for rejection,” present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Thus, by bringing the intended scope of the amendments to the Examiner’s attention, Applicants are merely requesting a full and fair hearing that is confined to as few actions as is consistent with a thorough consideration the merits of the Application, which is clearly in line with the USPTO’s efforts for expediting the prosecution of the case.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.125PA) any necessary fees for this filing.

Respectfully submitted,

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